

§ 103(a) as being unpatentable over *Riedl*, U.S. Patent No. 5,010,778 in view of *Crum et al.*, U.S. Patent No. 6,276,230. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Riedl* in view of *Crum et al.*, as applied to claim 1 above, and further in view of *Garnjost et al.*, U.S. Patent No. 5,347,884. Finally, Claim 9 was further rejected under 35 U.S.C. § 103(a) as being unpatentable over *Riedl* in view of *Crum et al.*, as applied to claim 1 above, and further in view of *Garnjost et al.*, U.S. Patent No. 5,347,884.

More particularly, the Examiner states that the *Waschulewski* reference discloses a soil compacting device that includes an oscillator, and at least one moving operator element (60) to control the positioning unit (36). The Examiner goes on to admit that *Waschulewski* does not disclose using a position sensor in a servo arrangement. Nevertheless, the Examiner states that *Crum et al.* teaches a handle bar mounted controller for powered machinery, and thus concludes that it would have been obvious to one of ordinary skill in the art to provide the soil compactor of *Waschulewski*, with the position sensor arrangement of *Crum et al.* Applicant respectfully disagrees.

Initially, applicant disagrees that the Bowden cable 60 of *Waschulewski* provides a teaching of the operator element of the claimed type. An operator element, by definition, is configured to be engaged by the operator. The claimed operator element is configured to both steer the soil compaction device and control its direction of travel. This is in contrast to the relatively complex *Waschulewski* Bowden cable 60, which is a downstream part of a complex shifting device that provides a mechanical link which, through manipulation by the user, is used to only shift the compactor. It *cannot* steer the compactor. Shifting forces must be generated by the operator and transmitted to the Bowden cable by some unspecified operator-manipulated structure. Those mechanical forces are then transmitted mechanically

to the eccentric to effect a shift operation. As such, *Waschulewski* does not teach the operator element of claim 1.

In addition, although *Crum et al.* teach a handle bar mounted controller, integrating the *Crum et al.* controller with the Bowden cable arrangement of *Waschulewski* would not yield the present invention. Incorporating the controller of *Crum et al.* in the *Waschulewski* compactor would render the complex shifting arrangement/Bowden cable coupled to a positioning device unnecessary. In other words, the structure in *Waschulewski* that the Examiner contends is the operator element (the Bowden cable coupled to further structure to provide corresponding movement of the compactor) would no longer be present in such a hypothetical combination. Therefore, the applied references would not produce the claimed combination. Therefore, applicant respectfully contends that the combination of claim 1 is not obvious in view of the teachings of *Waschulewski* and *Crum et al.*

Moreover in this regard, applicant notes that the motivation to combine these references must come from the references themselves. Clearly, in addition to the fact that there is no explicit motivation provided by the references themselves, there was no motivation to combine these references at all, as doing so would require eliminating critical structure from the apparatus of the primary reference *Waschulewski*, namely, portions of the complex shifting arrangement including the Bowden cable. In other words, a complete redesign of the *Waschulewski* compactor would be required, and the resulting product would not include an “operator element” as defined by the rejected claims.

Finally, and further supporting applicant’s argument regarding lack of motivation to combine, applicant contends that the combination including the *Crum et al.* teaching is inappropriate as *Crum et al.* is non-analogous art. *Crum et al.* is directed to a *throttle mechanism* that is employed in a system, such as a jet-ski, that requires some sort of

controller to perform the desired operation, i.e., controlling a power source. All of Crum's teachings revolve around a throttle control. Throttle controls of the type disclosed in Crum are very simple. They require nothing more than twisting of a twist grip for their implementation. The degree of throttle movement is proportional to the stroke of the twist grip. These teachings cannot be logically applied to a much more complex steering and propulsion control system of the type employed by a vibratory plate compactor. Hence, even if one were to combine Waschulewski and Crum (against the clear teachings of the references), the resulting system would only shift the direction of movement of the vibration plate upon manipulation of some unspecified operator control. It would not both steer and shift the machine.

In view of the above, independent claim 1, and claims 2-9 dependent therefrom, are novel and non-obvious in view of *Waschulewski* and *Crum et al.*

Next, with respect to the Examiner's rejection of claims 1-5 and 8 as being unpatentable over *Stoecker* in view of *Ishibashi et al.*, the Examiner states that *Stoecker* discloses an operating element in the form of handle 16 to control a positioning unit at 93, 111, and goes on to conclude that it would have been obvious to one of ordinary skill in the art to combine the *Stoecker* compactor with the position sensor of *Ishibashi et al.* Applicant respectfully disagrees. Similar to our previous argument with respect to *Waschulewski*, the handle 16 of the *Stoecker* compactor performs physical work to steer the compactor in contrast to the operator element of the present invention. The handle 16 itself lacks the capability of either shifting or steering the machine. Shifting is instead performed by manipulating a separate shift lever 93 by kicking a kick plate 116. As with *Waschulewski*, manual actuation of the lever 93 through the kick plate 116 mechanically shifts the machine's linkage to change its direction of travel. As with *Waschulewski*, steering is performed purely

manually. Moreover, in view of this fact, there was no motivation or suggestion in the references to combine the sensor of *Ishibashi et al.* with the *Stoecker* compactor as the combination would not yield the present invention as defined in the rejected claims. Incorporating the *Ishibashi et al.* teaching in the *Stoecker* device would render the kick plate 116 useless. In other words, the combination would not include an easily positionable “operator element,” as required by Claim 1, and therefore the combination would not provide a teaching of all the limitations of the rejected claims. Even if one were to replace the kick plate with some sort of servo controller (of which many are undoubtedly known for unrelated applications), replacing the kick plate 116 with a servo controller would not produce the claimed invention because the resulting device would merely shift *Stoecker*’s tamper, it would not steer it.

Overall, it is axiomatic that the motivation to combine prior art references must come from the references themselves and in view of the structures of the *Waschulewski* and *Stoecker* compactors, there would be no motivation to include such a position sensor as disclosed in *Crum et al.* or *Ishibashi et al.* with either of these devices. As a result, claim 1 defines over the cited references.

Notwithstanding the above, applicant has presented new claims 10-18 to more particularly define additional features of the present invention (claims 10-12 dependent from independent claim 1), and more particularly define the most preferred embodiment in claims 13-18. In particular, independent claim 13 additionally requires that the control element be provided on the guide handle. In contrast, *Waschulewski* fails to specify any location for a control element, and *Stoecker*’s kick plate 116 is located remote from the handle 16. As such, each of these added claims is in compliance with 35 U.S.C. §§ 102 and 103. Claim 14 additionally requires that the control element comprise a pair of independently movable

control handles that control the positioning unit. By coordinating movement of the control handles, the user is able to easily steer the compactor as outlined in the specification of the present application. Nothing in the cited references hints at this structure.

In sum, because the references in combination do not teach the present invention as defined in the rejected claims, applicant believes that each of the rejected claims 1-9 defines over the cited and applied art. Moreover, each of the added claims including dependent claims 10-12 dependent from claim 1, and new independent claim 13 as well as claims 14-17 dependent therefrom, are likewise allowable. An indication to his effect is respectfully requested. Should the Examiner have any additional concerns or wish to discuss the above for any reason, he is invited to contact the undersigned at the number appearing below.

Enclosed is a check in the amount of \$110 for a one-month extension of time which applicant hereby requests. No other fees are believed to be payable with the submission of this amendment. However, the Director is authorized to charge any fees associated with this or any other communication, or credit any overpayment, to Deposit Account No. 50-1170.

Respectfully submitted,



Timothy E. Newholm
Registration No. 34,400

Dated: January 8, 2003

BOYLE FREDRICKSON NEWHOLM
STEIN & GRATZ S.C.
250 Plaza, Suite 1030
150 East Wisconsin Avenue
Milwaukee, WI 53202
Telephone: (414) 225-9755
Facsimile: (414) 225-9753